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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/209, 932 07/08/98 BAHAR

B 0769-4582-US

IM62/0121

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EXAMINER

COPENHEAVER, B

ART UNIT	PAPER NUMBER
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1771

DATE MAILED:

01/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. <b>09/209,932</b>	Applicant(s) <b>Bahar et al.</b>
Examiner <b>Blaine R. Copenheaver</b>	Group Art Unit <b>1771</b>

Responsive to communication(s) filed on Nov 12, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 99-254 is/are pending in the application.

Of the above, claim(s) 144-171, 181-188, 217-232, and 241-244 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 99-143, 172-180, 189-216, 233-240, and 245-254 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 6 & 7

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant's election of Group I (claims 99-143, 172-180, 189-216, 233-240 and 245-254) in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 144-171, 181-188, 217-232 and 241-244 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected Group.
2. Claims 189-216, 233-240 and 245-254 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a polymeric microporous support, does not reasonably provide enablement for a generic support material, which reads on embodiments other than polymeric microporous materials, such as metal and inorganic matrices. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The use of a polymeric microporous material is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See Abstract, Summary of the Invention and Examples.
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 99-143, 172-180, 189-216, 233-240 and 245-254 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application Nos. 08/931,909; ~~08~~<sup>09</sup>/315,997; 09/137,515; and 09/245,496. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US '909, US '997, US '515, and US '496 are of a slightly different scope than the present claims. However, the scope of the claims in US '909, US '997, US '515, and US '496 read on embodiments within the scope of the present claims and vice versa.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 99-143, 172-180, 189-216, 233-240 and 245-254 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,547,551. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '551 patent discloses an ultra-thin composite membrane consisting essentially of a microporous polymeric sheet having impregnated in the pores and through the entire sheet an ion-exchange material. The ion-exchange material fully fills and occludes the pores of the microporous material, so that the composite membrane is

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impermeable. While US '551 does not specifically disclose the ionic conductance of the membrane, US '551 uses the same materials in the same amounts and thicknesses as the present invention. Thus, it is the examiner's position that the membrane of US '551 inherently exhibits an ionic conductance within the presently claimed ranges. In summary, the scope of US '551 reads on embodiments within the scope of the present claims and vice versa.

6. Claims 99-143, 172-180, 189-216, 233-240 and 245-254 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,599,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '614 patent discloses a composite membrane consisting essentially of a microporous polymeric sheet having impregnated in the pores and through the entire sheet an ion-exchange material. The ion-exchange material fully fills and occludes the pores of the microporous material, so that the composite membrane is impermeable. While US '614 does not specifically disclose the ionic conductance of the membrane, US '614 uses the same materials in the same amounts and thicknesses as the present invention. Thus, it is the examiner's position that the membrane of US '614 inherently exhibits an ionic conductance within the presently claimed ranges. In summary, the scope of US '614 reads on embodiments within the scope of the present claims and vice versa.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,635,041 is cited to some the state of the art.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine R. Copenheaver whose telephone number is (703) 308-1261. The examiner can normally be reached on Tuesday-Friday from 6:30 AM-4:00 PM and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Terrel H. Morris, can be reached at (703) 308-2414. The fax numbers for Technology Center 1700 are (703) 305-7718 and (703) 305-3601.



Blaine R. Copenheaver  
Primary Examiner  
Art Unit 1771

B. Copenheaver  
January 7, 2000